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In re Application of : DECISION ON THE PETITION
Mitchell R. Swartz : UNDER 37 CFR 1.181
Application No. 09/750,765 :
Filed: December 28, 2000 :
For: METHOD AND APPARTUS TO CONTROL
ISOTOPIC FUEL LOADED WITHIN A
MATERIAL

This is a decision on applicant's petitions filed on April 26, 2004 and May 28, 2004 under 37 CFR 1.181, to the Notice of non-Compliant Appeal Brief dated March 31, 2004.

The petition is **DENIED**.

RELEVANT HISTORY

On **September 8, 2003**, applicant filed a Notice of Appeal appealing the final rejection made on March 20, 2003.

On **October 28, 2003**, applicant filed an Appeal Brief.

On **December 30, 2003**, a Notice of Non-Compliance with 37 CFR 1.192(c) was mailed to the applicant. The Notice indicated that: the status of the claims was inconsistent, the status of the amendments was confusing, the summary of the invention was improper, the scope of the issues was improper, the grouping of claims was improper, the arguments section was improper, the listing of the claims in Appendix A was incorrect and the purpose of Appendix B was unclear. A detailed discussion of these issues can be found in the Notice. Applicant was given a one-month extendable time period to correct the defects.

On **January 7, 2004** a second Appeal Brief was filed.

On **March 31, 2004** a letter was mailed to the applicant indicating that the second Appeal Brief remained defective. The letter stated that "applicant states in the grouping of the Claims Section that the 'appealed claims do not stand or fall together.' However, there is still no discussion in the Arguments section of why EACH claim is considered separately patentable." The letter further indicated that: the grouping of the claims was still improper, the rejected claims by the examiner in the Final office action were not the same claims being addressed in the Appeal Brief, Appendix A claim listing was still incorrect and the purpose of Appendix B was still unclear. A detailed discussion of these issues can be found in the Notice.

The letter stated "Since the above deficiencies have been listed in the 12/30/03 Office Action, Applicant's failure to correct them is no longer considered inadvertent." Additionally the examiner stated "Since the period for reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a)."

On April 23, 2004, a third Appeal Brief was filed.

On April 26, 2004, Applicant petitioned the previous Notices of non-Compliant Appeal Briefs.

On May 28, 2004, Applicant filed a second petition addressing the Notices of non-Compliant Appeal Briefs.

DISCUSSION

As a formal matter, applicant was given an extendable one-month period for response on December 30, 2003. Applicant's statutory time period for adequately responding to this letter would have expired on June 30, 2004. A complete and adequate reply would have been required to adequately address the defects cited in the December 30, 2003 letter and pay any required extension of time due at the time of response. A review of the file and facts indicated above reveals that applicant's response filed on January 4, 2004 was timely; however, the second Appeal Brief filed was again non-compliant as addressed in the Notice of non-Compliance dated March 31, 2004. The Notice of non-Compliance indicated that applicant's response was no longer considered to be inadvertent and the period for reply would not extend beyond the June 30, 2004 time period. Applicant filed a third Appeal Brief dated April 23, 2004. Note that no fees for the extension of time have been paid. Therefore, applicant's application will be considered abandoned as of June 30, 2004 unless this decision determines that the examiner's action of March 31, 2004 was completely in error.

Additionally, it is recognized that appellant is a *pro-se* applicant. MPEP 1206 states: "An exception to the requirement that all the items specified in 37 CFR 1.192(c) be included in the brief is made if the application or reexamination proceeding is being prosecuted by the appellant *pro se*, i.e., there is no attorney or agent of record, and the brief was neither prepared nor signed by a registered attorney or agent. The brief of a *pro se* appellant which does not contain all of the items, (1) to (9), specified in 37 CFR 1.192(c) will be accepted as long as it substantially complies with the requirements of items (1), (2), and (8). If the brief of a *pro se* appellant is accepted, it will be presumed that all the claims of a rejected group of claims stand or fall together unless an argument is included in the brief that presents reasons as to why the appellant considers one or more of the claims in the rejected group to be separately patentable from the other claims in the group."

There are no issues in this petition with respect to items 1 and 2. For the record, item 8 is outlined below:

(8) Argument. The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading.

- (i) For each rejection under 35 U.S.C. 112, first paragraph, the argument shall specify the errors in the rejection and how the first paragraph of 35 U.S.C. 112 is complied with, including, as appropriate, how the specification and drawings, if any, (A) Describe the subject matter defined by each of the rejected claims, (B) Enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims, and (C) Set forth the best mode contemplated by the inventor of carrying out his or her invention.
- (ii) For each rejection under 35 U.S.C. 112, second paragraph, the argument shall specify the errors in the rejection and how the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- (iii) For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.
- (iv) For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.
- (v) For any rejection other than those referred to in paragraphs (c)(8)(i) to (iv) of this section, the argument shall specify the errors in the rejection and the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error.

In light of the above, it has been determined that the requested relief with respect to most of the issues is grantable, giving consideration to appellants pro-se status; the exception being the issues with respect to section 8 of this rule.

With respect to the letter mailed March 31, 2004, the examiner's position is that the Argument section does not properly address the 35 USC 101 rejections , 35 USC 112, first and second paragraph rejections and the 35 USC 102 rejection for each claim as appellant indicates that the claims do not stand or fall together.

Appellant addresses this issue at pages 4-6 of the May 28, 2004 petition. Appellant states that the Examiner is inaccurate for several reasons. The independent claims and all claims were addressed.

This argument is not found to be persuasive. The arguments, some of which, are addressed more fully below:

"First, once again, the Examiner has been unresponsive to Applicant's arguments even though they were fully discussed in significant detail in the previous Communication from the Applicant to the Examiner." A review of this part of the Brief, however, failed to reveal any argument with respect to these claims or separate arguments for each claim as appellant identified that the appealed claims do not stand or fall together. Additionally, a review of the Brief section with respect to the rejections under 35 USC 101, 112 and 102 failed to reveal any argument with respect to this issue raised by the examiner wherein each claim must be separately argued since appellant indicated that the claims do not stand or fall together.

"Second, Applicant's response clearly DOES NOT confirm what the Examiner has stated in his mutually disparate harassing Notices." This argument cannot be addressed as the intent of this statement is unclear.

"Third, Appellant requested why (since Appellant has been before the Board previously) the Examiner has included this NEW dictum which has never been used before. Appellant asked the Examiner to affirm that ALL other Appeal Briefs before the Board get similar harassing treatment." In response, as set forth more fully above, given appellant's *Pro Se* status under 37 CFR 1.192(c) an Appeal Brief will be accepted as long as it substantially complies with the requirements of items (1), (2), and (8). Appellant has not complied with item (8). The requirements set forth above are not new nor is the examiner's response to appellant considered to be harassing treatment. This argument is without merit or basis.

"Fourth, in Appellant's previous Communication, the Applicant took the time to respond to the Examiner and wrote the following Arguments about the Examiner's sweeping and precisely incorrect statements." Review of this section reveals again that appellant is arguing only the independent claims. As set forth more fully above, appellant has indicated that the claims do not stand or fall together. Thus, each claim must be separately argued.

"Third, Appellant respectfully disputes this because the Office is nonspecific, consistent with confabulation (*vide supra, vide infra*)" In response, this issue cannot be addressed in that appellant has not provided any facts or evidence to support this conclusion with respect to the new matter issue at hand.

"Fourth, Appellant already made changes because the Office demanded it in the previous first Communication, as discussed above. Appellant took the time and money to make new briefs in triplicate". In response, this argument has no bearing on whether or not Appellant addressed the new matter rejection of issue.

"Eighth, Appellant notes that this confabulation suggests obstruction of justice under color of law by the Office." In response, this argument is without merit or basis.

In conclusion, the examiner was correct in holding the Appeal Brief received by the Office on January 4, 2004 as non-compliant with 37 CFR 1.192(c)(8).

The Petitions of April 26, 2004 and May 28, 2004 are **DENIED**.

After mailing of this petition, the application will be forwarded to the examiner for dismissal of the appeal and for holding the application abandoned.

Any questions or comments with respect to this decision should be forwarded to Jack W. Keith in writing.



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DTH/jwk: 4/10/06